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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,720	01/28/2005	Takashi Kawakami	261514US6PCT	7446
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
HEYI, HENOK G				
ART UNIT		PAPER NUMBER		
2627				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/522,720

Applicant(s)

KAWAKAMI, TAKASHI

Examiner

HENOK G. HEYI

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.
2. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-10 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The data transferring program claimed in claims 8-10 is a judicial exception which is not a patent eligible subject matter. Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (*In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008)) indicate that a statutory "process" under 35 U.S.C. 101 must (1)

be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing.

While the instant claim recites a step of transforming audio data between a first recording medium and a second recording medium, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method step, and therefore does not qualify as a statutory process. For example, transferring audio data between a first recording medium and a second recording medium is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed verbally or without a machine.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 3 and 4 provisionally rejected on the ground of nonstatutory double patenting over claim 1 of copending Application No. 10/519,833. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Current Application	Copending Application – 10/519,833
1. A data transferring system for transferring audio data between a first recording medium and a second recording medium, a plurality of first sets each of which is composed of at least one entity of audio data having been recorded on the first recording medium, the data transferring system comprising: a second set that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to entities of audio data contained in each of the first sets; and a controlling portion for transferring all entities of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium when audio data described in the second set are transferred to the second recording medium.	1. <u>A content data transferring system for transferring content data selected from a first recording medium on which a plurality of content data have been recorded to a second recording medium</u> , the content data transferring system comprising: a recording and reproducing apparatus for reproducing various types of recording medium identification information unique to the second recording medium and recording content data transferred from the first recording medium to the second recording medium; first set creating means for creating a first set, the first set being used to correlate the recording medium identification information with a second set, the second set being used to categorize the content data recorded on the first recording medium in accordance with a predetermined rule; second set creating means for creating the second set correlated with the first set; reproduction control

	<p><u>information creating means for creating reproduction control information about the content data with the second set; and content transfer controlling means for transferring content data recorded on the first recording medium to the second recording medium so as to record the content data onto the second recording medium in accordance with the reproduction control information created in accordance with the recording medium identification information about the second recording medium,</u> the recording medium identification information being reproduced by the recording and reproducing apparatus.</p>
<p>3. The data transferring system according to claim 1, wherein the second recording medium has identification information unique thereto.</p>	<p>1. A content data transferring system for transferring content data selected from a first recording medium on which a plurality of content data have been recorded to a second recording medium, the content data transferring system comprising: <u>a recording and reproducing apparatus for reproducing various types of recording medium identification information unique to the second recording medium and recording content data transferred from the first recording medium to the second recording medium;</u> first set creating means for creating a first set, the first set being used to correlate the recording medium identification information with a second set, the second set being used to categorize the content data recorded on the first</p>

	<p>recording medium in accordance with a predetermined rule; second set creating means for creating the second set correlated with the first set; reproduction control information creating means for creating reproduction control information about the content data with the second set; and content transfer controlling means for transferring content data recorded on the first recording medium to the second recording medium so as to record the content data onto the second recording medium in accordance with the reproduction control information created in accordance with the recording medium identification information about the second recording medium, the recording medium identification information being reproduced by the recording and reproducing apparatus.</p>
<p>4. The data transferring system according to claim 3, wherein the identification information unique to each recording medium is correlated with the first sets.</p>	<p>1. A content data transferring system for transferring content data selected from a first recording medium on which a plurality of content data have been recorded to a second recording medium, the content data transferring system comprising: <u>a recording and reproducing apparatus for reproducing various types of recording medium identification information unique to the second recording medium and recording content data transferred from the first recording medium to the second recording medium; first set creating means for creating a first set, the first set being</u></p>

	<p><u>used to correlate the recording medium identification information with a second set</u>, the second set being used to categorize the content data recorded on the first recording medium in accordance with a predetermined rule; second set creating means for creating the second set correlated with the first set; reproduction control information creating means for creating reproduction control information about the content data with the second set; and content transfer controlling means for transferring content data recorded on the first recording medium to the second recording medium so as to record the content data onto the second recording medium in accordance with the reproduction control information created in accordance with the recording medium identification information about the second recording medium, the recording medium identification information being reproduced by the recording and reproducing apparatus.</p>
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Regarding claim 1, 3 and 4 the first set of audio data and second set of audio data is similar to what has been claimed in the copending application – 10/519,833. The reproduction order and pointers in the second set are obvious variants of identification information and predetermined rule in the copending application. They are both used to identify tracks in album and point to the right playlist.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masaharu JP 2003-029795 A in view of applicant's admitted prior art of Fig. 3 and further in view of Kato US 2004/0213552 A1 (Kato hereinafter).

Re claim 1, Masaharu teaches a data transferring system for transferring audio data between a first recording medium and a second recording medium (system which can transmit a music content from digital filing apparatus to digital player apparatus, para [0001]), a plurality of first sets defining albums, each of which includes at least one track of audio data having been recorded on the first recording medium (two or more musical pieces to a digital memory player from a personal computer, para [0002]), and a controlling portion for transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium when audio data described in the second set are transferred

to the second recording medium (the user needs to advance selection of a musical piece, and transmission, caring about the data volume of the musical piece used as a transmission plug until the memory of a digital memory player fills, para [0002]) but Masaharu fails to explicitly teach the data transferring system comprising: a second set that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to entities of audio data contained in each of the first sets. However, applicant's admitted prior art, Fig. 3, shows relation of albums and a play list according to an embodiment of the present invention as claimed in claim 1 and also shown in Fig. 52 of the specification. The only difference between Fig. 3 and Fig. 52 is that in Fig. 3, only songs that are part of the playlist are transferred while in Fig. 52 the whole album is transferred. To meet this deficiency of the admitted prior art, Examiner introduces Kato that teaches a transfer of not only playlist file but also the transfer of AV stream file and clip information file (see Fig. 61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the known method of applying pointers and keeping the reproduction order in a second set while transferring data (both playlist file and other data) from a personal computer to another recording and reproducing medium or apparatus. The modification would have been obvious because of the benefit of link pointers in the playlist while transferring data from personal computer to a recording and reproducing apparatus.

Re claim 2, Masaharu teaches the data transferring system according to claim 1, wherein the second recording medium is a detachable disc-shaped recording medium (desorbed type memory of digital player, para [0009]).

Re claim 3, Masaharu teaches the data transferring system according to claim 1, wherein the second recording medium has identification information unique thereto (identification data of a desorbed type memory of digital player apparatus, para [0009]).

Re claim 4, Masaharu teaches the data transferring system according to claim 3, wherein the identification information unique to each recording medium is correlated with the first sets (identification data of a desorbed type memory of digital player apparatus, and a batch transmission means, it is judged whether capacity data and identification data which are contained in a selected favorite list file are in agreement with capacity data of a desorbed type memory of digital player apparatus and identification data, para [0009]).

Re claim 5, Masaharu teaches a data transferring method for transferring audio data between a first recording medium and a second recording medium (system which can transmit a music content from digital filing apparatus to digital player apparatus, para [0001]), a plurality of first sets defining albums, each of which includes at least one track of audio data having been recorded on the first recording medium (two or more musical pieces to a digital memory player from a personal computer, para [0002]), the method comprising: receiving a command operable to transfer audio data described in a second set from the first recording medium to the second recording medium, the second set defining a play list and describing the reproduction order of audio data contained in

at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data contained in each of the first sets; searching first sets that contain audio data described in the second set; and transferring tracks of audio data described in the second set from the first recording medium to the second recording medium and transferring all tracks of audio data contained in the first sets that contain audio data that are transferred from the first recording medium to the second recording medium (the user needs to advance selection of a musical piece, and transmission, caring about the data volume of the musical piece used as a transmission plug until the memory of a digital memory player fills, para [0002]).

Re claim 6, Masaharu teaches the data transferring method according to claim 5, wherein the second recording medium has identification information unique thereto (identification data of a desorbed type memory of digital player apparatus, para [0009]).

Re claim 7, Masaharu teaches the data transferring method according to claim 6, wherein the identification information unique to each recording medium is correlated with the first sets (identification data of a desorbed type memory of digital player apparatus, and a batch transmission means, it is judged whether capacity data and identification data which are contained in a selected favorite list file are in agreement with capacity data of a desorbed type memory of digital player apparatus and identification data, para [0009]).

Re claim 8, Masaharu teaches a data transferring program for transferring audio data between a first recording medium and a second recording medium (system which

can transmit a music content from digital filing apparatus to digital player apparatus, para [0001]), a plurality of first sets defining albums, each of which includes at least one tracks of audio data having been recorded on the first recording medium (two or more musical pieces to a digital memory player from a personal computer, para [0002]), comprising: receiving a command operable to transfer audio data described in a second set from the first recording medium to the second recording medium, the second set defining a play list and describing the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data contained in each of the first sets; searching first sets that contain audio data described in the second set; and transferring tracks of audio data described in the second set from the first recording medium to the second recording medium and transferring all tracks of audio data contained in the first sets that contain audio data that are transferred from the first recording medium to the second recording medium (the user needs to advance selection of a musical piece, and transmission, caring about the data volume of the musical piece used as a transmission plug until the memory of a digital memory player fills, para [0002]).

Re claim 9, Masaharu teaches the data transferring program according to claim 8, wherein the second recording medium has identification information unique thereto (identification data of a desorbed type memory of digital player apparatus, para [0009]).

Re claim 10, Masaharu teaches the data transferring program according to claim 8, wherein the identification information unique to each recording medium is correlated with the first sets (identification data of a desorbed type memory of digital player

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apparatus, and a batch transmission means, it is judged whether capacity data and identification data which are contained in a selected favorite list file are in agreement with capacity data of a desorbed type memory of digital player apparatus and identification data, para [0009]).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENOK G. HEYI whose telephone number is (571)270-1816. The examiner can normally be reached on Monday to Friday 8:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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